

## REMARKS

The present application was filed on September 26, 2003 with claims 1 through 25. Claims 1, 2, 4-7, 11-14, 16-19 and 23-25 are presently pending in the above-identified patent application.

5 In the Office Action, the Examiner rejected claims 1, 2, 4, 12, 13, 16 and 24-25 under 35 U.S.C. §103(a) as being unpatentable over Nozawa et al. (United States Patent No. 6,942,157) in view of Cheung et al. (United States Patent No. 6,577,157) and further in view of Tamagno et al. (United States Publication No. 2004/0215471), rejected 5-7 and 17-19 under 35 U.S.C. §103(a) as being unpatentable over Nozawa et al. in view of Cheung et al. in view of 10 Tamagno et al. and further in view of Welch (United States Publication No. 2004/0097246), and rejected claims 11 and 23 under 35 U.S.C. §103(a) as being unpatentable over Nozawa et al. in view of Cheung et al. in view of Tamagno et al. and further view of Schmidt (United States Publication No. 2002/0196029).

### Independent Claims 1, 13 and 25

15 Independent claims 1, 13, and 25 were rejected 35 U.S.C. §103(a) as being unpatentable over Nozawa et al. in view of Cheung et al. and further in view of Tamagno et al.

With regard to claim 1, for example, the Examiner asserts that Nozawa et al. teach transmitting a wireless signal from said integrated circuit device to said monitoring station using an antenna associated with said integrated circuit device. Nozawa et al., however, is directed to 20 wireless communication *among* IC Chips (see, e.g., col. 1, lines 65-67 – “Most significantly, it is an object of the invention to provide such systems and methods in which the IC chips communicate with one another in a wireless manner.”).

Thus, contrary to the Examiner’s assertion, Nozawa et al. do not disclose or suggest “transmitting a wireless signal from said integrated circuit device *to said monitoring station*,” as required by claim 1 (emphasis added).

25 The Examiner acknowledges that Nozawa et al. do not teach “wherein said antenna is a pin on said integrated circuit device,” but asserts this feature is taught by Cheung.

Cheung teaches that “integrated circuit device with programmable pins is more versatile in terms of pin assignment.” Col. 3, lines 60-62. Contrary to the Examiner’s assertion, Cheung *teaches away* from using a pin as an antenna for wireless communications. Cheung’s discussion of antennas indicates an *undesired* result, namely, that “unused pins are sometimes left to float.

5 However, the floating unused pins tend to act as antennas and generate noise within the device.”

Thus, a person of ordinary skill in the art would not combine Nozawa et al. and Cheung et al. in the manner asserted by the Examiner.

10 The Examiner acknowledges that Nozawa et al. and Cheung et al. do not teach “monitoring station performs one or more of testing, debugging and evaluating said integrated circuit,” but asserts that Tamagno et al. teaches this feature.

Applicants concurrently file herewith a Declaration of Prior Invention Under 37 C.F.R. §1.131. The attached Declaration establishes conception of the invention prior to the effective date of Tamagno et al., coupled with due diligence from prior to such effective date until the filing date of the present application.

15 As indicated in the Declaration, the invention was conceived at least as early as April 4, 2003 as evidenced by the internal Agere Systems Invention Submission, Submission No. 124672, entitled “Wireless IC Debugging and Monitoring.” Applicant maintains that the cited exhibits demonstrate conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to the filing of the application.

20 Accordingly, Applicants assert that, since the filing date of Tamagno et al is April 23, 2003, Tamagno et al. is not a proper prior art reference.

Applicants respectfully request the withdrawal of the rejection of pending claims.

25 However, for purposes of advancing prosecution of the present application, Applicant notes that Tamagno et al. *teaches away* from wireless communications between an integrated circuit device and a monitoring station that is debugging the integrated circuit. Tamagno et al. specifically shows wired connections between the integrated circuit device (smart card 20) and the monitoring station (host 12). See, e.g., Fig. 1.

Thus, Applicant respectfully requests withdrawal of the Section 103 rejection.

Dependent Claims 2, 4-12 and 14-24

Dependent claims 2, 4-12 and 14-15 were rejected under 35 U.S.C. §102(e) as being anticipated by Richman. Claims 2, 4-12 and 14-15 are dependent on claims 1 and 13, 5 respectively, and are therefore patentably distinguished over Nozawa et al., Cheung et al., Tamagno et al., Welch and Schmidt, alone or in any combination, because of their dependency from amended independent claims 1 and 13 for the reasons set forth above, as well as other elements these claims add in combination to their base claim.

All of the pending claims, i.e., claims 1, 2, 4-14, and 16-25, are in condition for 10 allowance and such favorable action is earnestly solicited.

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

The Examiner's attention to this matter is appreciated.

15 Respectfully submitted,



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